

REMARKS

Claim Rejections – 35 U.S.C. § 102

Claims 13, 17, 18, 20, and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kutscher *et al.* (U.S. Patent 6,212,451).

Applicant respectfully requests that the Examiner reconsider the rejection on the grounds that the cited reference does not provide all of the elements of independent claim 13.

MPEP 2131 requires that to anticipate a claim, the reference must teach *every element* of the claim. The following guidance is provided:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >“When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection.

In the present case, independent Claim 13 requires the specific step of "determining a currently applicable estimated temperature ($T_s(T_c)$), taking into account the heating and cooling behavior of the compressor". Claim 13 also requires that the estimated temperature ($T_s(T_c)$) is calculated by a control unit. The step of estimating the temperature is therefore a distinct element and the temperature is represented inside of the control unit.

Applicant respectfully submits that Kutscher *et al.* does not specify the specific step performed in the specific manner that is described in Claim 13. The Examiner also effectively acknowledges the same in the instant Office Action. In particular, the Examiner indicates that in Kutscher *et al.*, the "compressor temperature is indirectly estimated through the use of heat transfer rates." The word "indirectly" serves as a placebo or a hand waving to try and excuse an element that simply does not exist nor is inherent in Kutscher *et al.*

As best understood, Kutscher *et al.* operates by measuring the ambient temperature proximate the air compressor and then operating the air compressor in a manner that is suitable, i.e. will not allow the compressor temperature to exceed a predetermined threshold, based on the environment. Kutscher *et al.* never estimates the actual temperature of the compressor and as such there is nothing in its disclosure that is identical or inherently provides the Applicant's claimed functionality.

Applicant also respectfully submits the following operating example as further evidence that Kutscher *et al.* does not "indirectly" calculate the compressor temperature. Suppose a situation where the compressor transitions from a cool air environment to a hot air environment, such as may occur when exiting from an underground tunnel. The system described by Kutscher *et al.* would immediately reduce the compressor duty cycle upon sensing the hotter air.

Conversely, the applicant's claimed system would take into consideration not only the hotter air, but also the heating and cooling behavior of the compressor. Therefore, if the compressor remained off while in the tunnel the Applicant's system would take that into account and allow the compressor to run longer than the compressor in Kutscher *et al.* This is precisely because Kutscher *et al.* does not explicitly or inherently have any estimate of the compressor temperature at any moment

in time. For these reasons Applicant submits that Kutscher *et al.* does not anticipate Claim 13 and respectfully requests that the Examiner reconsider the 35 USC 102(b) rejection.

Claims 13, 15, and 17-24 depend either directly or indirectly from Claim 13 and are believed to be in a condition for allowance for at least the same reason as Claim 13.

CONCLUSION

Applicant believes that all claims are now in proper shape for allowance.

Respectfully submitted,

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